UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/823,655	04/14/2004	Tadashi Tsukamoto	Q80949	4962

23373   7590   04/21/2008
SUGHRUE MION, PLLC
2100 PENNSYLVANIA AVENUE, N.W.
SUITE 800
WASHINGTON, DC 20037

EXAMINER
HENNING, MATTHEW T

ART UNIT	PAPER NUMBER
2131	

MAIL DATE	DELIVERY MODE
04/21/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/823,655	TSUKAMOTO, TADASHI
	Examiner	Art Unit
	MATTHEW T. HENNING	2131

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>14 April 2004</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-20</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-20</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>14 April 2004</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☒ All   b)☐ Some * c)☐ None of:

      1.☒ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date <u>See Continuation Sheet</u>.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :4/14/04; 11/14/05; 12/15/05; 4/6/06.

1   This action is in response to the communication filed on 4/14/2004.

2   **DETAILED ACTION**

3   Claims 1-20 have been examined.

4   *Title*

5   The title of the invention is not descriptive. A new title is required that is clearly

6   indicative of the invention to which the claims are directed.

7   ***Information Disclosure Statement***

8   The information disclosure statement(s) (IDS) submitted on 4/14/2004, 11/14/2005,

9   12/15/2005, and 4/6/2006 are in compliance with the provisions of 37 CFR 1.97. Accordingly,

10   the examiner is considering the information disclosure statements.

11   *Drawings*

12   The drawings filed on 4/14/2004 are acceptable for examination proceedings.

13   *Specification*

14   Applicant is reminded of the proper language and format for an abstract of the disclosure.
15
16   *The abstract should be in narrative form and generally limited to a single paragraph on*
17   *a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed*
18   *150 words in length since the space provided for the abstract on the computer tape used by the*
19   *printer is limited. The form and legal phraseology often used in patent claims, such as "means"*
20   *and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist*
21   *readers in deciding whether there is a need for consulting the full patent text for details.*
22
23   *The language should be clear and concise and should not repeat information given in the*
24   *title. It should avoid using phrases which can be implied, such as, "The disclosure concerns,"*
25   *"The disclosure defined by this invention," "The disclosure describes," etc.*
26
27   The abstract of the disclosure is objected to because:

28   "The present invention provides" can be implied and therefor should be removed.

29   Correction is required. See MPEP § 608.01(b).

1   ***Claim Objections***

2   Claims 5-6 are objected to because of the following informalities: The word "copying"

3   has been misspelled. Appropriate correction is required.

4   ***Claim Rejections - 35 USC § 101***

5   35 U.S.C. 101 reads as follows:

6   Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or
7   any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and
8   requirements of this title.
9
10   Claim 20 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-

11   statutory subject matter. In this case, the claims are directed towards a computer program *per se*.

12   The computer program *per se* is nothing more than non-functional descriptive language.

13   Because the claim does not recite that the computer program is embodied on a tangible medium,

14   such as a computer readable storage medium, acting as computer component to realize its

15   functionality, the claim is directed only to non-functional descriptive language. Therefore, the

16   claims in question do not appear to fall within a statutory category of invention as set forth in 35

17   USC 101.

18   ***Claim Rejections - 35 USC § 102***

19   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

20   basis for the rejections under this section made in this Office action:

21   *A person shall be entitled to a patent unless –*

22   *(b) the invention was patented or described in a printed publication in this or a foreign*
23   *country or in public use or on sale in this country, more than one year prior to the date of*
24   *application for patent in the United States.*
25

1   Claims 1, 4-9, 11-13, 15, 17, and 19 are rejected under 35 U.S.C. 102(b) as being

2   anticipated by Sashihara et al. (US Patent Application Publication 2002/0165008) hereinafter

3   referred to as Sashihara.

4   Regarding claims 1 and 13, Sashihara disclosed a mobile terminal (Sashihara Fig. 2)

5   capable of identifying an authorized user (Sashihara [0004]: SIM based systems are capable of

6   identifying authorized users using the SIM card), when a user connects a detachable memory

7   medium to the mobile terminal (Sashihara [0004]: SIM card mounting), based on identification

8   (ID) information stored in the memory medium (Sashihara [0004]: SIM identification

9   information), comprising: memory area creating means for creating a memory area, which is

10   unique to each authorized user, in association with the ID information of the user (Sashihara

11   [0049]: the given area of the external memory where the encrypted ID is stored); encrypting

12   means for reading out ID information from the memory medium connected to the mobile

13   terminal (Sashihara [0051]: registered ID read from SIM), and encrypting personal contents fed

14   to the mobile terminal-on the basis of the ID information (Sashihara [0051]: encrypts the read

15   private data using the registered ID); storing means for storing the encrypted personal contents in

16   a specific memory area associated with the ID information (Sashihara [0051] and [0075]: stores

17   the encrypted result into the external memory); and decrypting means for reading out ID

18   information from the memory medium connected to the mobile terminal (Sashihara [0020]: read

19   out the registered identification code from the subscriber card), and decrypting, based on the ID

20   information, the personal contents encrypted and stored in the specific memory area associated

21   with the ID information, thereby rendering the personal contents accessible to the user (Sashihara

22   [0021]: decoding the data makes it accessible to the user that mounted the card).

1   Regarding claim 20, Sashihara disclosed that programs control the operation of the phone

2 in which the method is described (Sashihara [0008]).

3   Regarding claim 4, Sashihara disclosed information sharing means which allows the

4 users at least either to write contents into a common memory area, which is shared by a plurality

5 of authorized users, or to gain access to contents stored in the common memory area. (Sashihara

6 [0021]: storing the decoded data in internal memory).

7   Regarding claim 5, Sashihara disclosed operation means for, when the memory medium

8 is connected by the user to the mobile terminal and the personal contents is accessible by the

9 user, at least either coping or transferring the personal contents to the common memory area in

10 accordance with the user's operation (Sashihara [0021]).

11   Regarding claim 6, Sashihara disclosed operation means for, when the memory medium

12 is connected by the user to the mobile terminal and the personal contents is accessible by the

13 user, at least either coping or transferring information stored at the common memory area to the

14 specific memory area associated with the ID information in accordance with the user's operation

15 (Sashihara [0051]: reading the data stored in the EEPROM and storing it in the external

16 memory).

17   Regarding claims 7 and 15, Sashihara disclosed that the encrypting means generates a

18 cryptographic key based on ID information read out from the memory medium connected to the

19 mobile terminal, and encrypts personal contents using the cryptographic key (Sashihara [0049]

20 and [0051]).

21   Regarding claims 8 and 17, Sashihara disclosed decrypting means generates a

22 cryptographic key on the basis of ID information read out from the memory medium connected

1   to the mobile terminal, and decrypts the encrypted personal contents stored in the specific

2   memory area associated with the ID information by using the cryptographic key (Sashihara

3   [0021]).

4   Regarding claim 9, Sashihara disclosed that the ID information is a subscriber

5   information used for identifying a subscriber who is authorized to receive service to be provided

6   via the mobile terminal, or a serial number uniquely assigned to the mobile terminal (Sashihara

7   [0004].

8   Regarding claim 11, Sashihara disclosed that the mobile terminal is shared by a plurality

9   of users and comprises a fixed specific memory area uniquely assigned to each of the user

10   (Sashihara [0070]: where the private data is stored is assumed to be predetermined...for each

11   registered user); said storing means, when the encrypted personal contents of a user is stored in

12   the fixed memory area specifically assigned to the user, attaches a tag on a header portion of the

13   fixed memory area (Sashihara [0049]: stores an encrypted ID into a given area of the external

14   memory); and said decrypting means, when it is required to decrypt the encrypted personal data,

15   determines the fixed memory area specifically assigned to the user by seeking the tag based on

16   the ID information read from the memory medium currently connected to the mobile terminal

17   (Sashihara [0060] – [0064]).

18   Regarding claims 12 and 19, Sashihara disclosed that the memory medium is an IC card

19   based on a common standard (Sashihara [0004]).

1   *Claim Rejections - 35 USC § 103*

2   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

3   obviousness rejections set forth in this Office action:

4   *A patent may not be obtained though the invention is not identically disclosed or*
5   *described as set forth in section 102 of this title, if the differences between the subject matter*
6   *sought to be patented and the prior art are such that the subject matter as a whole would have*
7   *been obvious at the time the invention was made to a person having ordinary skill in the art to*
8   *which said subject matter pertains. Patentability shall not be negatived by the manner in which*
9   *the invention was made.*
10

11   Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sashihara.

12   While Sashihara disclosed dynamic management of storing the encrypted data in the

13   external memory, and decrypting the data read from the external memory (Sashihara [0049]-

14   [0051] and [0060]-[0064]), Sashihara failed to specifically disclose that the data is managed as

15   data files having a varied size in accordance with file management information. However,

16   storing data as files of varying size is well known in the art of data storage. As such, it would

17   have been obvious to the ordinary person to have stored the data as files of varying size. This

18   would have been obvious <u>because</u> the ordinary person skilled in the art would have been

19   motivated to utilize what was well known in the art.

20   Claims 2-3, 14, 16, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable

21   over Sashihara as applied to claims 1 and 13 above, and further in view of Chujo et al. (US

22   Patent Application Publication 2002/0023156) hereinafter referred to as Chujo.

23   While Sashihara disclosed that the encrypting means generates a cryptographic key based

24   on ID information read out from the memory medium connected to the mobile terminal, and

25   encrypts personal contents using the cryptographic key (Sashihara [0049] and [0051]); and

1   further that the decrypting means generates a cryptographic key on the basis of ID information

2   read out from the memory medium connected to the mobile terminal, and decrypts the encrypted

3   personal contents stored in the specific memory area associated with the ID information by using

4   the cryptographic key (Sashihara [0021]), and the memory area creating means includes means

5   for, when the memory medium is connected to the mobile terminal, providing a subordinate

6   memory area associated with the specific memory area in accordance with the user's operation

7   (Sashihara [0049] and [0051]: the storing of the encrypted data in the memory area), Sashihara

8   failed to specifically said memory area creating means automatically creates, in response to the

9   memory medium being connected to the mobile terminal, the specific memory area in

10   association with the ID information stored in the memory medium.

11   Chujo teaches that in a shared storage system, in order to ensure that each user does not

12   store excessive amounts of data, a "reserve space" of the storage device should be automatically

13   allocated to each user (Chujo [0005] and [0078]).

14   It would have been obvious to the ordinary person skilled in the art at the time of

15   invention to have employed the teachings of Chujo in the storage system of Sashihara by

16   allocating a reserve space in the external storage for each user of the phone. This would have

17   been obvious because the ordinary person skilled in the art would have been motivated to ensure

18   that each user does not store excessive amounts of data.

19   *Conclusion*

20   Claims 1-20 have been rejected.

21   The prior art made of record and not relied upon is considered pertinent to applicant's

22   disclosure.

1   Any inquiry concerning this communication or earlier communications from the

2   examiner should be directed to MATTHEW T. HENNING whose telephone number is

3   (571)272-3790. The examiner can normally be reached on M-F 8-4.

4   If attempts to reach the examiner by telephone are unsuccessful, the examiner's

5   supervisor, Ayaz Sheikh can be reached on (571) 272-3795. The fax phone number for the

6   organization where this application or proceeding is assigned is 571-273-8300.

7   Information regarding the status of an application may be obtained from the Patent

8   Application Information Retrieval (PAIR) system. Status information for published applications

9   may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

10   applications is available through Private PAIR only. For more information about the PAIR

11   system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

12   system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would

13   like assistance from a USPTO Customer Service Representative or access to the automated

14   information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

15

16   /Matthew T Henning/

17   Examiner, Art Unit 2131

18   /Ayaz R. Sheikh/

19   Supervisory Patent Examiner, Art Unit 2131